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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,212	02/18/2000	Seiji Yamashita	P 00 572.006	8199

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Garth Janke
Birdwell & Janke & durando,p PLC
1100 SW SITH AVENUE , SUITE 1400
Portland, OR 97204

EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1711

21

DATE MAILED: 01/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/507,212

Applicant(s)

YAMASHITA, SEIJI

Examiner

Thao T. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 14-18, 20, 21 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13, 19, 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This is in response to the Amendment received on October 30, 2002. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
2. Claims 1-21, 23, and 25 are currently pending in this application. Claims 22 and 24 have been cancelled. Claims 1-9, 14-18, 20-21, and 25 have been withdrawn from further consideration as non-elected inventions as set forth in Paper No. 4.
3. Claims 10-13, 19, and 23 have been elected by original presentation in Paper No. 4 and therefore are being examined below.

Claim Rejections - 35 USC § 112

4. In view of the prior Office Action of June 25, 2002, the rejection of claims 10-13, 19, and 23 under 35 U.S.C. 112, first paragraph, has been withdrawn due to the Amendment made thereto.
5. In view of the prior Office Action of June 25, 2002, the rejection of claims 10-13, 19, and 23 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the Amendment made thereto.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 10-13, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Goto et al. (US Pat. 6,235,358).

In regards to claim 10, Goto teaches an apparatus for reducing contamination (sanitary characteristics), comprising a plastic container (see plastic packaging container, col. 13, ln. 12), and a coating on selected portions of the container, wherein the coating consists essentially of titanium dioxide (see abstract; col. 3, ln. 12-41; col. 7, ln. 2-6; col. 13, ln. 12-15). The examiner is interpreting that selected portions of the container being the container.

Goto further teaches that the coating layer is a resin composition, comprising a cationic curable resin comprising an alicyclic epoxy resin, a photo-cationic-curing catalyst, a sensitizer, and a pigment comprising titanium dioxide (see abstract). Goto also discloses the epoxy resin being 100 parts per 250 parts by weight of titanium dioxide, the photo-catalyst being 1 to 20 parts, and the sensitizer 1.5 to 5 parts per 100 parts by weight of titanium dioxide (see col. 3, ln. 12-21). Hence, titanium dioxide would inherently be an essential component of Goto's resin composition in the coating layer, and therefore, Goto's coating layer would also inherently attract atmospheric water as presently claimed.

Note: On page 4 of the instant specification, Applicant discloses that the coating, in addition to titanium dioxide, may include other chemicals that are relatively hydrophilic. The examiner is interpreting that chemicals, such as the alicyclic epoxy resin of formula (3) (see col. 5, ln. 22-40) containing oxygen as taught by Goto, would be relatively hydrophilic.

Moreover, with respect to the limitation, “so as to attract atmospheric water molecules to produce a hydrophilic surface on the container for facilitating cleaning the container”; it has been well settled that limitations on the properties of the material worked upon or functional limitations have been held to have insignificant patentable weight in an apparatus claim. See **MPEP** 2114-2115.

With respect to the preamble “for reducing particle contamination of an article” and limitation “adapted for holding the article”; it has been within the skill in the art that an intended use clause in the preamble would have very little significant patentable weight in a method or apparatus claim. See **MPEP** 2111.02. Moreover, the limitation “adapted for holding the article” is not a positive limitation. In addition, since the prior art teaches a plastic container, a container should be able to hold an article; and since the prior art’s container is also coated with titanium dioxide, the prior art’s container should be able to perform the same function as that in the instant claim.

In regards to claim 11, Goto teaches the container including a closeable lid for sealing the interior of the container from the external atmosphere (plastic can) (see col. 10, ln. 15-53, col. 13, ln. 13-14).

In regards to claims 12-13, Goto teaches the container including polypropylene and polycarbonate (see col. 13, ln. 29-35).

In regards to claim 23, Goto teaches the coating comprising a gel (paint) (see col. 15, ln. 49-54; Table 1).

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Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goto as applied to claim 10 above, and further in view of Nyseth (US Pat. 5,575,394).

Goto is as set forth in claim 10 above and incorporated herein.

Goto differs from the instant invention because the reference does not teach at least one semiconductor wafer disposed in the container. However, the reference further teaches that the thickness of the can bottom portions differs depending upon the use of the container (see col. 11, ln. 21-24), indicating that the container would be used for different purposes.

Nyseth teaches the use of a plastic container storing semiconductor wafers, hence including semiconductor wafers in the container (see abstract; col. 1, ln. 26-31).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used a plastic container of Goto to store semiconductor wafers as taught by Nyseth, because Nyseth teaches that the use of a plastic container would minimize the likelihood of contamination of the wafers with particulate contaminants (see col. 1, ln. 26-31).

Response to Arguments

10. In the Declaration, received on October 30, 2002, Applicant provides various opinions to state that Goto's coating layer is different from the presently claimed invention. However,

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merely stating one's opinions cannot be scientifically founded to show the novelty of the present invention over the prior art. It is recommended that Applicant provide concrete scientific evidence, such as experimental data including comparative examples, to show different results that are patentably distinguishable from the prior art.

11. Applicant's arguments filed October 30, 2002 have been fully considered but they are not persuasive.

In response to applicant's request on the withdrawal of the Restriction Requirement, since this application contains claims 1-9, 14-18, 20-21, and 25 which are drawn to an invention nonelected with traverse in Paper No. 4, and since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-9, 14-18, 20-21, and 25 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

On page 3 of the Remarks, Applicant alleges, "the coating of Goto does not consist essentially of titanium dioxide so as to attract 'atmospheric water molecules to produce a hydrophilic surface on the container for facilitating cleaning the container'". However, as pointed out in paragraph 7 above, the coating layer of Goto contains 100 parts of the epoxy resin per 20 to 250 parts by weight of titanium dioxide, the photo-catalyst being 1 to 20 parts and the sensitizer 1.5 to 5 parts by weight per 100 parts by weight of titanium dioxide (see col. 3, ln. 12-21). Hence, titanium dioxide would inherently be an essential component of the coating of Goto, and therefore, Goto's coating would also inherently attract atmospheric water as presently claimed.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. This application contains claims 1-9, 14-18, 20-21, and 25, drawn to an invention nonelected with traverse in Paper No. 4. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 703-306-5698. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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January 8, 2003



James J. Seidlock
Supervisory Patent Examiner
Technology Center 1700